

**REMARKS**

Claims 1-47 are pending in the present application. Claims 1-47 have been rejected. No claims have been allowed. Claims 1, 6-7, 11, 16-17, 24, 27, 29, 31, 34, 36 and 39-41 have been amended. Claims 5, 15, 26, 33, 38 and 42 have been canceled. No new claims have been added.

**I. Interview Summary**

Examiners Brown and Zimmerman are hereby acknowledged and thanked for the courtesy extended during the personal interview on January 17, 2006, at the United States Patent and Trademark Office, between the Examiners, Keith Moore, and the undersigned attorney. The pending claims, current Office Action and prior art were all discussed during this personal interview, with particular focus on claims 1, 4, 5 and later analogous claims, as well as that which is clearly taught by the primary prior art references used. Agreement was reached with respect to the recited references not teaching all elements of dependent claim 5, which has been incorporated into independent claim 1 herein. Similar amendments have also been made with respect to all analogous claims. Agreement was also reached with respect to the explanation provided below being adequate to address the pending indefiniteness rejections.

**II. Claim Rejections under 35 U.S.C. § 112**

Claims 1-10 and 37 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. In particular, the Office Action states, "Regarding claims 1-10, . . . The key as claimed . . . represents an electro-mechanical key and not a purely mechanical key." Further, the Office Action also states, "Claims 4 and 37 are rejected . . . [because] The examiner does not understand what is meant by any other step." Applicants respectfully traverse these rejections.

IGT1P102

-11-

While it is true that many embodiments of the present invention do involve the use of an electromechanical key, it is axiomatic that such a key must be mechanical. That is, any given electromechanical key will at the same time be an electrical key and also a mechanical key. Further, it is axiomatic that all "electromechanical keys" are a subset of the larger grouping of "mechanical keys." Applicants respectfully submit that there might be many ways of utilizing the various keys, locks, devices and methods disclosed in the present application, and that at least some of the intended objectives might be accomplished through use of a mechanical key that is not also an electromechanical key. Because of this possibility, and because of the fact that an electromechanical key is by definition a mechanical key as well, Applicants respectfully submit that the present claim language to the broader term "mechanical key" is appropriate.

With respect to the claim language "any other step" in claims 4 and 37, Applicants respectfully submit that such a step could be any other step within the particular claim. That is, the "any other step" of either of claims 4 or 37 could be any of the recited receiving, reading, authorizing or permitting steps particular to these claims. Although Applicants submit that the present remarks are adequate to clarify that which is being claimed, Applicants are willing to amend claims 4 and 37 to reflect this definition if the Examiner still feels that such amendments remain necessary. Applicants respectfully submit that the pending indefiniteness rejections have been overcome hereby, and thus request the withdrawal of these rejections.

### **III. Claim Rejections under 35 U.S.C. § 102**

Claims 24-25 and 28-30 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,826,450 to Lerchner, et al. ("Lerchner"). In particular, the Office Action states, "Lerchner teaches . . . reading a second source of indicia . . . [that] comprises user specific

data . . . (col. 4 lines 21-29)," and that, "The data stored in the key (col. 6 lines 42-46) is the PIN information." Applicants respectfully traverse these rejections.

In order to anticipate a claim, a reference must teach every material element of that claim. Claim 24 recites, *inter alia*, "a correct second source of indicia *with respect to the user* of said mechanical key" (emphasis added). A careful review of Lerchner, and particularly the passages at col. 4 lines 21-29 and col. 6 lines 42-46 does not reveal any indicia that is *particular to the user of the key*. Rather, Lerchner teaches that its "key can be coded only electronically" (col. 3 lines 23-24), and that such "electronic coding of the key then serves mainly as a personal code and additional security code to be recognized by the transponder reading device" (col. 3 lines 31-33). While Lerchner does use the term "personal" in this description, such a term primarily refers to the individual keys and locks, and not as a source of indicia that is definitively particular to the actual user of the key. For example, in the present invention, various embodiments use the fingerprint or some other biometric indicia from the user of the key. If the key were then handed from the correct person to an unauthorized person for use at the lock, the second source of indicia would not work for that lock, since it would be an incorrect fingerprint or other biometric. Conversely, in Lerchner, such a key handoff at the lock would work, since the coding on the key is not a source of indicia that is truly "with respect to the user" of the key. That is, the coding of Lerchner is built into the key, and could be used for *any* user of the key until such a coding is changed. For this reason, it is respectfully submitted that Lerchner does not teach the material element of "a correct second source of indicia *with respect to the user* of said mechanical key." Applicants thus respectfully request the withdrawal of the pending § 102 rejections.

Nevertheless, in order to expedite prosecution, Applicants have agreed to amend the pending claims as has been accomplished herein. Applicants respectfully reserve the right to

pursue the original broader claims in a continuation or divisional application. In particular, claim 24 has been amended to specify that the "said second source of indicia comprises biometric information with respect to said user of said mechanical key." Applicants respectfully submit that Lerchner does not teach such an indicia of biometric information with respect to a key, and that none of the recited prior art cures this deficiency of Lerchner. Accordingly, independent claim 24 is patentable over the recited prior art. Because dependent claims 25 and 28-30 all depend from claim 24, these claims are all also patentable over the recited prior art for at least the same reasons as for claim 24.

#### IV. Claim Rejections under 35 U.S.C. § 103

Claims 1-3, 11-14, 20, 23, 31-32, and 35-36 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,439,996 to LeMay, et al. ("LeMay") in view of Lerchner. In addition, claims 4-8 and 14-18, 26-27, 33-34, 37-40 stand rejected as being unpatentable over LeMay, further in view of U.S. Patent No. 6,709,333 to Bradford, et al. ("Bradford"). Claims 9 and 19 also stand rejected as being unpatentable over LeMay, Lerchner and Bradford, in further view of U.S. Patent No. 6,374,653 to Gokcebay, et al. ("Gokcebay"). Claims 10 and 21-22 stand rejected as being unpatentable over LeMay in view of Lerchner and Gokcebay. Claims 41, 43-44, and 45-47 stand rejected over LeMay in view of Lerchner, and further in view of U.S. Patent No. 6,945,870 to Gatto, et al. ("Gatto"). Claim 42 stands rejected over LeMay in view of Lerchner in view of Gatto and further in view of Bradford. In particular, the Office Action states, "Lerchner . . . teaches . . . reading a second source of indicia [that] comprises user specific data (col. 4 lines 21-29)" and "Bradford . . . teaches embedding the

biometric identification information in a key (col. 5 lines 36-51).” Applicants respectfully traverse these rejections.

To establish a *prima facie* case of obviousness, a proffered combination of prior art references must teach or suggest all of the claim limitations. *See, e.g.*, MPEP § 2143. In addition, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or combine reference teachings. *See id.* Applicants respectfully submit that neither of these requirements is met by the obviousness rejections as set forth in the Office Action. Applicants also submit that should a *prima facie* case of obviousness be established, that other factors and/or secondary considerations that serve to rebut such obviousness rejections can be provided. Applicants believe it to be unnecessary to present each of these additional factors and/or secondary considerations here, however, since the initial burden of making a *prima facie* case of obviousness has not yet been met, and because the presentation of such factors and considerations ordinarily involves a substantial amount of resources and time. Accordingly, Applicants respectfully reserve the right to present such additional information should a *prima facie* case of obviousness be established.

#### All Claim Limitations Not Within The Prior Art

In order to render a claim as obvious, a purported combination of references must contain every material element of that claim. *See* MPEP § 2143. Applicants initially reiterate the points made above regarding the failure of Lerchner to teach an apparatus or step relating to reading a second source of indicia that comprises *user specific* data. Again, it is respectfully submitted that while the data in question may be specific to the key or lock, Lerchner does not teach of data that is specific to the *user*. That is, virtually any person in the world could use the key and lock

of Lerchner so long as the "personal code" on its key has not been changed. As noted above, the term "personal code" in Lerchner relates to the correct code for the key and lock, and not to data or indicia that is truly specific to the *user*. Conversely, the present invention and claims are directed toward reading data or indicia that are truly specific to the user of the key, such as a fingerprint, biometric or other personal data or indicia. As such, all pending rejections based on the presumption that "Lerchner . . . teaches . . . reading a second source of indicia [that] comprises user specific data" fail for at least this first reason.

Furthermore, Applicants respectfully submit that Bradford does not teach embedding biometric identification information in a key, and that no other recited prior art reference cures this defect of Bradford. While the Office Action points to Bradford at col. 5 lines 36-51 for the proposition that Bradford teaches embedding biometric identification information in a key, a careful read of all of Bradford, and this passage in particular, reveals otherwise. The only use of the word "key" or any related word within this passage is stated within context as follows:

A non-exhaustive list of first authenticators that are expected to be in use now or in the near future include: . . . embedded RFID tags (may be in a key fob, a wallet-sized card . . . );

As can be seen, the only thing that is proposed to be embedded in a key fob (but not a key), is an RFID tag, with no mention being made of such a tag or any other item having or being adapted to read or provide biometric information. For at least this additional second reason, all pending rejections based on the presumption that "Bradford . . . teaches embedding the biometric identification information in a key" fail as well.

Although all claims are allowable over the prior art for at least the first reason given above, Applicants have nevertheless agreed to amend all claims to include the limitation that at least one source of indicia be biometric information specific to one or more users of the key. For

example, dependent claim 5 has been canceled and effectively incorporated into independent claim 1 for this purpose. Other analogous claim amendments have been made such that all pending claims now recite the element of "biometric information." These amendments have been made in order to expedite prosecution of the present application, and Applicants respectfully reserve the right to pursue the originally broader claims in a continuation or divisional application at a later time. As a result of these amendments, it is submitted that all claims are now allowable over the prior art of record for at least both of the reasons provided above, and Applicants thus respectfully request that these claims be passed to issuance.

No Motivation To Combine Within The Prior Art

The teaching or suggestion to make the claimed combination must be found in the prior art, and not based upon the disclosure of the Applicant. *See* MPEP § 2143. Also, the level of skill in the art cannot be relied upon to provide the suggestion to combine references, and the mere fact that references can possibly be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the claimed combination. *See* MPEP § 2143.01. Although the Office Action states that "It would have been obvious to one of ordinary skill in the art to . . ." at various locations, the Office Action fails to provide any motivation from within the prior art to make the proposed changes in many instances. For example, the Office Action states the foregoing, as well as ". . . to use biometric information as the user identification information in LeMay in view of Lerchner as suggested by Bradford because such would improve the ability to verify the identity of a person." Such a statement here, as similarly made in many of the other obviousness rejections, however, does not point to where in the prior art such motivation exists, as is required. Applicants respectfully submit that such a combination of references without showing the required motivation to

combine is improper on its face, such that the pending § 103 rejections are deficient for at least this reason as well.

### CONCLUSION

Applicants respectfully submit that all claims are in proper form and condition for patentability, and request a Notification of Allowance to that effect. Payment for a one-month extension of time petition fee is included herewith, and it is believed that no fees are due at this time. Should any further extension of time fee or any other fee be required for any reason related to this document, however, then the Commissioner is hereby authorized to charge said fee to Deposit Account No.50-0388, referencing Docket No. IGT1P102. The Examiner is respectfully requested to contact the undersigned attorney at the telephone number below with any questions or concerns relating to this document or application.

Respectfully Submitted,  
BEYER WEAVER & THOMAS, LLP



Justin A. White, Esq.  
Reg. No. 48,883

Date: March 29, 2006

Beyer, Weaver & Thomas LLP  
P.O. Box 70250  
Oakland, CA 94612-0250  
(650) 961-8300

IGT1P102

-18-